

REMARKS

Claims 1-21 are pending. No amendments have been made by way of the present submission, thus, no new matter has been added. Applicants further submit that no new issues have been raised by way of the present submission which would require additional search and/or consideration on the part of the Examiner.

In the event that the present submission does not place the application into condition for allowance, entry thereof is respectfully requested as placing the application into better form for appeal.

In view of the following remarks, Applicants respectfully request that the Examiner withdraw all rejections and allow the currently pending claims.

Objection to the Specification

The Examiner has objected to the Supplemental Combined Declaration and Power of Attorney which was filed on June 13, 2003. The Examiner asserts that it was improper since it did not enclose the part of the document that has been amended. Applicants disagree with the Examiner in this regard. First, there is no requirement for any portion of the document that has been amended to be attached. Second, the Supplemental Combined Declaration and Power of Attorney specifically stated that the application had been amended on November 22, 2002.

Reconsideration and withdrawal of this objection are requested.

Issues Under 35 U.S.C. §102(b)/103(a)

The Examiner has rejected claims 1 and 9-14 under 35 U.S.C. §102(b) as being anticipated by, or in the alternative, under 35 U.S.C. §103(a) as obvious over either JP 2000-10233 (which is equivalent to United States Patent Number 6,165,707 issued to Hirano and hereinafter referred to as Hirano '707) or U.S. Patent No. 6,100,022, issued to Inoue et al. (hereinafter referred to as Inoue '022).

The Examiner has also rejected claims 1 and 4-15 under 35 U.S.C. §102(b) as being anticipated by JP 2000-112072 (hereinafter referred to as JP '072).

The Examiner has also rejected claims 1-16 and 18-20 under 35 U.S.C. §103(a) as being obvious over JP '072.

Lastly, the Examiner has rejected claim 17 under 35 U.S.C. §103(a) as being obvious over JP '072 in view of Ito et al, U.S. Patent No. 6,150,084 (hereinafter referred to as Ito '084).

Applicants respectfully traverse each of the above rejections.

Applicants hereby incorporate all arguments previously made.

Distinctions Between the Present Invention and the Cited Art

Applicants respectfully submit that none of the references cited by the Examiner suggest or disclose condition (I) or

condition (II) as required by the present claims. Applicants have previously submitted a Declaration on November 22, 2002 (the Nakano Declaration). The Examiner continues to assert that this Declaration is unpersuasive since it does not shows the amount of ammonium ion in the LACSTAR 3307B binder rather that the amount of ammonium ion in the emulsion layers of the final product.

Accordingly, Applicants have conducted new experiments to definitively show that none of the primary references cited by the Examiner achieve the amounts of ammonium ion recited in the present claims. Illustratively, claim 1 of the present application, upon which all other claims depend, includes a limitation that the photothermographic material must satisfy at least one of Conditions I and II. Condition I includes the limitation that "the  $\text{NH}_4^+$  content in all the layers formed on the image-forming layer side of the support is 0.06 mmol/m<sup>2</sup> or less." Condition II includes the limitation that the "film surface pH of the image-forming layer side of the support is substantially unchanged after coating, and the layers formed on the image-forming layer side of the support do not substantially contain ammonia"

Importantly, each of Condition I and Condition II include limitations concerning specific compounds and specific amounts of ammonium ion or ammonia in the layers on the image-forming layer side of the support. If the cited art does not meet these limitations, there can be no inherency as suggested by the

Examiner. Moreover, absent some motivation to achieve these amounts of ammonium ion or ammonia, there exists no *prima facie* case of obviousness. And even if there is hypothetically a *prima facie* case of obviousness, a point not conceded by Applicants, the presently claimed subject matter achieves superior results not expected from the cited art, thus rebutting any hypothetical *prima facie* case of obviousness.

Attached hereto is a new Declaration under 37 CFR § 1.132 executed by Tokuju Oikawa (hereinafter referred to as the Oikawa Declaration). In the Oikawa Declaration, three samples (Samples 1, 2, and 3) are tested. Sample 1 was prepared according to Example 1 of Inoue '022, one of the primary references). Sample 2 was prepared according to Examples 1-2 of Hirano '707, another one of the primary references. Lastly, Sample 3 was prepared according to Sample 3 shown in Table 1 of JP '072.

A review of the results for each of Samples 1, 2 and 3 reveal that the amounts of ammonium ion in all the layers formed on the image forming side are outside of the claimed ranges. Samples 1, 2 and 3 contained 0.24, 0.26 and 0.23 mmol/m<sup>2</sup>, respectively, of ammonium ion in all the layers formed on the image forming layer side. However, Condition I of the claims requires that the amount of ammonium ion in all the layers formed on the image-forming layer side of the support be 0.06 mmol/m<sup>2</sup> or less. Condition II of the claims requires that the layers formed on the image-forming layer side of the support do not

substantially contain ammonia. Neither of these conditions is achieved by the cited art.

Applicants point out that the results of the Oikawa Declaration are conforming with the calculated values set forth in the Nakano Declaration, which asserted the amounts of ammonium ion would be about 0.25 mmol/m<sup>2</sup>.

Accordingly, the cited references of Inoue '022, Hirano '707 and JP '072 fail to achieve the presently claimed subject matter. Thus, no anticipation exists. Additionally, there also exists no *prima facie* case of obviousness. Specifically, there exists no motivation in any of the references including the secondary reference of Ito '084 to achieve the presently claimed subject matter. Thus, the Examiner has failed to present a valid *prima facie* case of obviousness. However, even if the Examiner has hypothetically established a *prima facie* case of obviousness, a point not conceded by Applicants, Applicants submit that the presently claimed subject matter achieve unexpectedly superior results compared to the cited art.

None of the art cited by the Examiner suggests or discloses that by utilizing specific compounds and specific amounts of ammonium ions, that lower temperature and lower humidity dependency would result. As shown in the Table 1 of the present specification, the claimed invention shows much lower temperature and humidity dependency than samples No. 1-3 and No. 1-8. Applicants submit that one skilled in the art could not have

expected that such excellent effects could be obtained by satisfying Condition I of the claimed invention.

Also, as shown in Table II of the present specification, the claimed invention shows much lower temperature and humidity dependency than comparative samples that do not satisfy Condition II. Applicants submit that one skilled in the art could not have expected that such excellent effects could be obtained by satisfying Condition II of claimed invention.

In view of the above, Applicants respectfully submit that the present claims define subject matter which is patentable over the cited art. Accordingly, the Examiner is respectfully requested to withdraw all rejections and allow the currently pending claims.

If the Examiner has any questions or comments, please do not hesitate to contact the undersigned at the offices of Birch, Stewart, Kolasch & Birch, LLP.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional

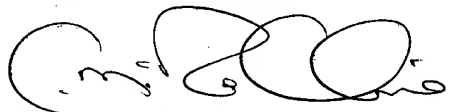
Application No. 09/928,339

fees required under 37 C.F.R. § 1.16 or under § 1.17;  
particularly, extension of time fees.

Respectfully submitted,

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